

REMARKS

Claims 1, 2, 4-8 and 10-13 are now in this application. Claims 1-8 and 10-12 are rejected. Claim 3 is cancelled herein. Claim 9 is previously cancelled. Claims 1, 4, 7 and 8 are amended herein to clarify the invention and to address matters of form unrelated to substantive patentability issues. New claim 13 is added.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objection cited in the above-referenced Office Action.

The drawing filed on February 10, 2004 is not found acceptable and is objected to because the text used in the correction is not the same size or uniformity of thickness as the other text as allegedly required by 37 CFR 1.84(l). A replacement sheet is attached, and includes a change to Fig. 2. This sheet replaces the original sheet and replacement sheet filed February 10, 2004, including Fig. 2, and revises the font size used in the labeling of flow diagram box (ST9), to address the drawing objection in the Office Action. Withdrawal of the drawing objection is earnestly requested.

Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lipson (US 5,435,554). Applicants herein respectfully traverse these rejections.

For a rejection to be sustained under § 102(b) each and every element of the claimed invention must be disclosed in the cited prior art reference. It is respectfully

submitted that the cited reference fails to disclose at least the following features and elements of the present invention as noted herein.

Independent claims 1, 7 and 8 are each amended to include a recitation which states that “alteration of a height and an orientation of the bat character is accomplished singly by the moving operation of said pointing device in cases where bunting is selected as the offensive action of said batting character.” As such, when bunting is selected, a height and direction of the bat character is altered by the single moving operation of the pointing device.

While the Examiner appears to be of the opinion lines 17 to 35 of column 14 of Lipson discloses a single operation of a pointing device to enable an adjustment of both a height of a bat and an orientation of the bat (see rejection of claim 3), the reference does not, in fact, appear to teach or suggest such claimed recitation.

In Lipson, the batter's control device 32 contains a joystick 18 and 3-button panel 22 (see Fig. 1b). The joystick 18 is to be used to determine the direction of a batted ball and the control panel 22 will be used to select a particular type of swing. Specifically, panel 22 is comprised of three buttons 37, 38 and 39 which represent a normal swing, a power swing and a bunt attempt, respectively (see col. 5, lines 15-20).

As described in the above passage, according to Lipson, a joystick 18 is used to determine the moving direction of the batted ball and the switches 37, 38, and 39 are used to select the batting type, i.e., and ordinary swing, power swing, or bunt

swing. Accordingly, applicants respectfully submit that Lipson does not disclose or hint the feature in accordance with which “designation of instructions for alteration of a height and an orientation of the bat character is accomplished singly by the moving operation of said pointing device,” as is now recited in amended claims 1, 7 and 8.

Independent claims 1, 7 and 8 are amended and particularly describe and distinctly claim elements not disclosed in the cited reference. Claims 2, 4, 5 and 6 depend from claim 1 and therefore also contain the element lacking in the cited Lipson reference. Therefore, reconsideration of the rejections of claims 1, 2 and 4-8 and their allowance are respectfully requested.

Claims 10-12 are rejected as obvious over Lipson under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness has not been established in the rejection of claims 10-12. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach

or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

The examiner states that the use of the mouse for a game player's inputs into a video game is well know. However, while the general use of a mouse in connection with a video game may be known, the use of a mouse in the manner as recited in claims 10, 11 and 12, or the suggestion to use the mouse in said manner, is clearly lacking support in the art cited in the rejection of the claims. Applicants note that the rejected claims do not claim a mouse as a part of a structural combination claim, but rather each describes a specific functional use of a mouse. Therefore, in order to properly establish a *prima facie* case of obviousness, applicants submit that the Examiner would be required to cite a reference which provides a suggestion or motivation to one of ordinary skill in the art to make specific functional use of a mouse for executing the particular process in a game in the manner as claimed.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference for the reasons stated above. Reconsideration of the rejections of claims 10-12 and their allowance are respectfully requested.

Claim 13 is added and is submitted as patentable over the cited art of record, insofar as it recites subject matter directed to a pointing device which is movable as a whole with respect to the monitor screen which, among other features recited therein, is not believed disclosed in the cited art in the manner as claimed. Favorable action on the merits is earnestly solicited.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
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enc: Replacement drawing sheet.